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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,271	08/31/2006	Stefan Gallinat	P29848	3145
7055 7590 12/22/2010 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER CLAYTOR, DEIRDRE RENEE				
ART UNIT		PAPER NUMBER		
1627				
NOTIFICATION DATE		DELIVERY MODE		
12/22/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

# Office Action Summary

**Application No.**

10/581.271

**Applicant(s)**

GALLINAT ET AL.

**Examiner**

Renee Claytor

**Art Unit**

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-30, 32-37 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-30, 32-37, 39-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

Applicants have amended the claims to overcome the 35 USC 112 rejections and the rejections are hereby withdrawn.

Upon further consideration, it is noted that the elected species of arctiin as component (a) has yielded no results; therefore, the search has been expanded to other species of component (a). Please see the new grounds of rejection based on expanding the search of component (a).

***Claim Rejections – 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Korte et al. (US Patent 7,582,677) in view of Max et al. (US PgPub 2005/0158350) and Tom Dieck (US PgPub 2005/0037042).

Korte et al. teach topical formulations for cosmetic or pharmaceutical use that include a lignan such as matairesinol (Col. 2, lines 17-22). The lignans such as matairesinol are present in the compositions in amounts ranging from 0.01-20% (see Examples 1-8). The lignans may be useful as active agents in topical preparations as anti-aging substances for treating signs of dermatological aging, both photoaging and

intrinsic aging, including skin wrinkles such as fine wrinkling around the mouth area, irregular pigmentation, sallowness, loss of skin resilience and elasticity (Col. 4, lines 23-30). They may also be useful as anti-inflammatory agents or as skin cancer preventing agents (Col. 4, lines 31-32).

Korte does not teach that the 2,3-dibenzylbutyrolactone derivatives are in combination with licochalcone A.

Max et al. teach cosmetic or dermatological preparations that contain licochalcone A for the treatment of postinflammatory skin conditions and contributes to a more even pigmentation of the skin (paragraphs 0019-0020). It is also taught that licochalcone A is useful for treating skin aging and the harmful effects of ultraviolet radiation on the skin (paragraph 0024). Max et al. teach concentrations of licochalcone A in the composition to range from 0.0001 to 5% by weight which overlaps with that in claims 24-26 (paragraph 0025). Max et al. teaches that polyols can be included in the composition in amounts ranging from 0.001 to 10% by weight, which overlaps with that in claims 28-30 (paragraph 0027). Max et al. teaches that the licochalcone A of the invention is a constituent of vegetable extracts, in particular *radix glycyrrhizae inflatae* (paragraphs 0028, 0032). Max et al. teach compositions that include licochalcone A and glycerin (meeting the limitation of the elected species of polyol) in amounts that overlap with those claimed in the present invention (see Examples 1-7, 9-13, 15-19).

Tom Dieck et al. teach the use of licochalcone A in cosmetic and dermatological preparations for the treatment of inflamed skin conditions and/or skin protection in dry

skin (paragraphs 0002, 0032, 0044). Tom Dieck et al. teach that carriers are used in the cosmetic and dermatological formulations (paragraph 0107).

Accordingly, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). One would be motivated to combine the teachings of Korte et al., which teaches cosmetic or pharmaceutical compositions comprised of 2,3-dibenzylbutyrolactone derivatives such as matairesinol, for the treatment of aging, skin wrinkles, irregular pigmentation and inflammation, with the teachings of Max et al. and Tom Dieck et al. which teach cosmetic and dermatological formulations comprised of licochalcone A for the treatment of skin conditions for treating skin aging and the harmful effects of ultraviolet radiation on the skin and treatment of inflamed skin conditions and/or skin protection in dry skin, because the 2,3-dibenzylbutyrolactone derivatives and licochalcone A are used in cosmetic and dermatological preparations for the same purpose and together may provide an enhanced effect.

### ***Conclusion***

No claims are allowed.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627